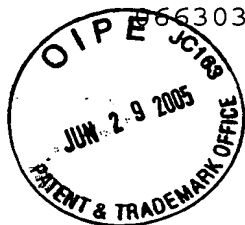ATTORNEY DOCKET NO.
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PATENT APPLICATION
09/685,274

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Eric Sean Parham, et al.

Serial No.:   09/685,274

Filing Date: October 9, 2000

Group Art Unit: 2662

Examiner: Dmitry Levitan

Title: SYSTEM AND METHOD FOR INTERFACING
                         BETWEEN SIGNALING PROTOCOLS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA   22313-1450

Dear Sir:

<u>APPEAL BRIEF</u>

Applicant has appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner mailed December 29, 2004, finally rejecting Claims 1-20. Applicant filed a Notice of Appeal on April 29, 2005. Applicant respectfully submits herewith their brief on appeal with a statutory fee of $250.00.

REAL PARTY IN INTEREST

The present application was assigned to General Bandwidth Inc., a Delaware corporation, as indicated by an assignment from the inventors recorded on February 21, 2001 in the Assignment Records of the United States Patent and Trademark Office at Reel 011554, Frames 0611-0616.

RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Claims 1-20 stand rejected pursuant to a Final Action mailed December 29, 2004. Claims 1-20 are all presented for appeal.

STATUS OF AMENDMENTS

A Response to Examiner's Final Action was filed on February 28, 2005 in response to the Final Action mailed December 29, 2004. No amendments were made to the claims. The Examiner issued an Advisory Action dated March 25, 2005 which stated that the Response to Examiner's Final Action was entered and considered but that it did not place the application in condition for allowance. A Notice of Appeal was filed on April 29, 2005.

SUMMARY OF CLAIMED SUBJECT MATTER

With respect to Claims 1-20, the present invention involves a telecommunications network (10) having a gateway (18) that receives signaling information in a media gateway and call session control format from a Class 5 Softswitch (26). The gateway (18) converts the media gateway and call session control format to a broadband loop emulation service signaling protocol for transfer to integrated access devices (20) at a customer premises (22) through a broadband loop emulation services network (14). The gateway (18) also receives signal information in a broadband loop emulation service signaling protocol from the integrated access devices (20) at the customer premises (22) through the broadband loop emulation services network (14). The gateway (18) converts the broadband loop emulation service signaling protocol to the media gateway and call session control format for transfer to the Class 5 softswitch (26). The Class 5 softswitch (26) places the media gateway and call session control format into a network signal format for transfer over a signaling network (24). See FIGURE 1 as well as page 5, line 1, to page 7, line 26, of Applicant's specification.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Did the Examiner err in concluding that Claims 1-20 were indefinite for failing to particularly point out and distinctly claim the subject matter of the invention under 35 U.S.C. §112, second paragraph?

2. Did the Examiner err in concluding that Claims 1-20 were obvious under 35 U.S.C. §103(a) over U. S. Patent No. 6,603,760 issued to Smyk?

ARGUMENT

1.   Claims 1-20 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner has indicated that the terms broadband loop emulation service signaling protocol, Class 5 softswitch, signaling information in a media gateway and call session control format to a Class 5 softswitch, and network signaling format to a Class 5 softswitch are not defined in the specification nor well known in the art. Applicant respectfully traverses this rejection.

With respect to the term "broadband loop emulation service signaling protocol", it is a well know term of art in the telecommunications industry and easily known by those skilled in the art. The article "Standardize and Deliver" previously submitted, though bearing a date after the filing date of the present Application, specifically states that the broadband loop emulation service and its protocol stack were known by those skilled in the art prior to the filing of the present Application and by as early as July and August 2000. Thus, those of skill in the art were familiar with the term "broadband loop emulation service signaling protocol" at the time of filing of the present Application.

With respect to the term "Class 5 softswitch", it is clearly known by those skilled in the art. The article entitled "TalkingNets to Implement telecom technologies' Flexible Softswitch Technology Within its Next-Generation Network" and bearing a date of June 6, 2000. The article specifically refers to a softswitch that provides Class 5 functionality. Thus, a Class 5 softswitch was well known to those skilled at the time of filing of the present Application.

With respect to the term "signaling information in a media gateway and call session control format to a Class 5

softswitch", specific examples of media gateway and call session control formats are defined at page 6, lines 11-14, of Applicant's specification. Moreover, the article entitled "TalkingNets to Implement telecom technologies' Flexible Softswitch Technology Within its Next-Generation Network" identified above specifically mentions media gateway devices in relation to a Class 5 softswitch. Thus, the term is well defined and those of skill in the art were familiar with the term "signaling information in a media gateway and call session control format to a Class 5 softswitch" at the time of filing of the present Application.

With respect to the term "network signaling format to a Class 5 softswitch", specific examples of a network signaling format, such as SS7, are defined at page 6, lines 17-22, of Applicant's specification. Moreover, the article entitled "TalkingNets to Implement telecom technologies' Flexible Softswitch Technology Within its Next-Generation Network" identified above specifically states that a softswitch can support SS7 and traditional telephony interfaces. Thus, the term is well defined and those of skill in the art were familiar with the term "network signaling format to a Class 5 softswitch" at the time of filing of the present Application.

According to the discussion above, all of the terms identified by the Examiner were fully known to those skilled in the art at the time of filing of the present Application and appropriately defined in Applicant's specification. Pursuant to M.P.E.P. §2171, the question is whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art. Thus, the Examiner's subjective lack of knowledge in the art is not sufficient by itself to support the indefiniteness rejection raised by the Examiner. As shown above, one of skill in the

art is very familiar with the language used in the claims. Therefore, Applicant respectfully submits that Claims 1-20 are in accordance with 35 U.S.C. §112, second paragraph.

2.   Claims 1-20 stand rejected under 35 U.S.C. §103(a)
as being unpatentable over Smyk. According to M.P.E.P. §2143,
to establish a prima facie case of obviousness, three criteria
must be met.   First, there must be some suggestion or
motivation to modify the reference.   Second, there must be a
reasonable expectation of success.   Third, the prior art must
teach or suggest all the claim limitations.   The Examiner has
not established that any criteria for a prima facie case of
obviousness has been met in this instance.

First, there is no suggestion or motivation in the Smyk
patent to modify it as proposed by the Examiner. The Examiner
readily admits that the Smyk patent fails to teach tone
generation and full detecting capabilities at the gateway.
The Examiner has not cited any language within the Smyk patent
that would suggest any capability for the Smyk patent to
provide tone generation and full detecting capabilities.   No
objective reasoning whatsoever was provided by the Examiner
for modifying the Smyk patent as has been proposed other than
through an improper hindsight reconstruction of the claimed
invention.   The Examiner has merely provided subjective
conclusory "it would have been obvious to modify" statements
using improper hindsight reconstruction without any support
for such conclusory statements from the Smyk patent or any
where else in the prior art. A statement that modifications
of the prior art to meet the claimed invention would have been
well within the ordinary skill of the art at the time the
claimed invention was made because the references relied upon
teaches that all aspects of the claimed invention were
individually known in the art is not sufficient to establish a
prima facie case of obviousness without some objective reason
to combine the teachings of the references.   See M.P.E.P.
2143.01.   Since the Examiner has not provided any proper

reasoning, let alone objective reasoning, the burden to establish the first criteria of a prima facie case of obviousness has not been met.

Second, a reasonable expectation of success has not been shown by the Examiner. The Examiner, without the improper hindsight look through the claimed invention, has not addressed how the proposed modification to the Smyk patent would have any success whatsoever let alone a reasonable expectation of success. Therefore, Applicant respectfully submits that the Examiner has failed to establish the second criteria for a prima facie case of obviousness.

Third, the Examiner has not shown that the Smyk patent teaches or suggests all of the claim limitations. Certain individual claims are highlighted below to show how the Smyk patent lacks disclosure for teaching all of the claim limitations.

Independent Claim 1

With respect to Independent Claim 1, there is recited ". . . a gateway operable to receive signaling information in a media gateway and call session control format, the gateway operable to convert the media gateway and call session control format to a broadband loop emulation service signaling protocol, the gateway operable to provide tone generation and detection capabilities pursuant to the signaling information." By contrast, the Smyk patent does not disclose a gateway that converts a media gateway and call session format to a broadband loop emulation service signaling protocol while also providing tone generation and detection as required by the claimed invention. The Smyk patent has no disclosure with respect to a broadband loop emulation service signaling protocol. In fact, as discussed above, the Examiner is not even aware of such a protocol or that it is known by those of

skill in the art. Moreover, the Examiner readily admits that the Smyk patent fails to teach tone generation and detection capabilities at the gateway. Thus, the Smyk patent does not have a gateway that is capable of performing the protocol conversion and the tone generation/detection functions provided in the claimed invention.

Additionally, Claims 3 and 9-11 recite a Class 5 softswitch. As pointed out by the Examiner, the Smyk patent clearly uses a Class 5 switch as opposed to the claimed Class 5 softswitch. The Class 5 switch of the Smyk patent cannot perform the function of converting the network signaling format to the media gateway and call session control format let alone providing and receiving the media gateway and call session control format as performed by the Class 5 softswitch provided in Claims 3 and 9-11. The portions of the Smyk patent cited by the Examiner merely show a media gateway control protocol between its service manager and its network gateway and not between its network gateway and its Class 5 switch. Moreover, as discussed above, the Examiner is not even aware of the existence of a Class 5 softswitch or that it is known by those of skill in the art. As a result, the Examiner is unable to comprehend the differences between a conventional Class 5 switch and a Class 5 softswitch and the different interfacing required to provide communications with a Class 5 softswitch as compared to a conventional Class 5 switch as shown in the claimed invention.

Independent Claim 14

With respect to Independent Claim 14, there is recited a task of ". . . converting the media gateway and call session control format to a broadband loop emulation service signaling protocol; providing tone generation and detection in response to the signaling information and instructions received from

the Class 5 softswitch." By contrast, the Smyk patent does not disclose a gateway that converts a media gateway and call session format to a broadband loop emulation service signaling protocol while also providing tone generation and detection as required by the claimed invention. The Smyk patent has no disclosure with respect to a broadband loop emulation service signaling protocol. As stated earlier, the Examiner does not know that a broadband loop emulation service signaling protocol exists. As a result, the Examiner cannot effectively reject the claimed invention based merely on the Smyk patent, especially when the Smyk patent fails to provide any relevant disclosure as to the claimed broadband loop emulation service signaling protocol. Moreover, the Examiner readily admits that the Smyk patent fails to teach tone generation and detection capabilities at the gateway. Thus, the Smyk patent does not have a gateway that is capable of performing the protocol conversion and the tone generation/detection functions provided in the claimed invention.

Additionally, Claim 14 requires receiving signaling information in a media gateway and call session control format from a Class 5 softswitch. As discussed earlier, the Smyk patent clearly uses a Class 5 switch as opposed to the claimed Class 5 softswitch. The Class 5 switch of the Smyk patent has no capability to provide signaling information in a media gateway and call session control format as required by the Class 5 softswitch of Claim 14. The portions of the Smyk patent cited by the Examiner merely show a media gateway control protocol between its service manager and its network gateway and not between its network gateway and its Class 5 switch.

Based on the reasoning above, the Smyk patent is insufficient by itself to support a rejection of the claims.

Therefore, Applicant respectfully submits that the Examiner has failed to establish the third criteria for a prima facie case of obviousness.

The three criteria necessary to establish a prima facie case of obviousness as spelled out in M.P.E.P. §2143 have not been mentioned by the Examiner let alone discussed in any detail. As shown above, the improper modification of the reference, the lack of any expectation of success for the modification, and the lack of disclosure in the reference for each and every limitation, clearly show that the Examiner has failed to properly support the rejections of the claims. Therefore, Applicant respectfully submits that Claims 1-20 are patentably distinct from the Smyk patent.

CONCLUSION

Applicant has clearly demonstrated that the present invention as claimed is clearly distinguishable over all the art cited of record, either alone or in combination, and satisfies all requirements under 35 U.S.C. §§101, 102, and 103, and 112. Therefore, Applicant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

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June 29, 2005

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APPENDIX A

1.   (Original) A system for interfacing between signaling protocols, comprising:

a gateway operable to receive signaling information in a media gateway and call session control format, the gateway operable to convert the media gateway and call session control format to a broadband loop emulation service signaling protocol, the gateway operable to provide tone generation and detection capabilities pursuant to the signaling information.

2.   (Original) The system of Claim 1, wherein the gateway is operable to receive signaling information in the broadband loop emulation service signaling protocol, the gateway being operable to convert the broadband loop emulation service signaling protocol to the media gateway and call session control format.

3.   (Original) The system of Claim 2, wherein the gateway is operable to provide the signaling information in the media gateway and call session control format to a Class 5 softswitch.

4.   (Original) The system of Claim 1, wherein the media gateway and call session control format follows a SGCP standard.

5.   (Original) The system of Claim 1, wherein the media gateway and call session control format follows a MGCP standard.

6.   (Original) The system of Claim 1, wherein the media gateway and call session control format follows a H.248 standard.

7.   (Original) The system of Claim 1, wherein the media gateway and call session control format follows a SIP standard.

8.   (Original) The system of Claim 1, wherein the media gateway and call session control format follows a H.323 standard.

9.   (Original) The system of Claim 1, further comprising:

a Class 5 softswitch operable to receive signaling information in a network signaling format, the Class 5 softswitch operable to convert the network signaling format to the media gateway and call session control format, the Class 5 softswitch operable to control incoming call requests from a network through the gateway according to the signaling information.

10.   (Original) The system of Claim 9, wherein the network signaling format is a SS7 signaling format.

11.   (Original) The system of Claim 9, wherein the gateway is operable to provide signaling information to the Class 5 softswitch in the media gateway and call session control format, the Class 5 softswitch operable to convert the media gateway and call session control format to the network signaling format.

12.   (Original) The system of Claim 1, wherein the broadband loop emulation services signaling protocol implements a channel associated signaling format.

13.   (Original) The system of Claim 1, wherein the broadband loop emulation services signaling protocol implements a common channel signaling standard.

14.   (Original) A method for interfacing between signaling protocols, comprising:

receiving signaling information in a media gateway and call session control format from a Class 5 softswitch;

converting the media gateway and call session control format to a broadband loop emulation service signaling protocol;

providing tone generation and detection in response to the signaling information and instructions received from the Class 5 softswitch.

15.   (Original) The method of Claim 14, wherein the media gateway and call session control format follows a MGCP standard.

16.   (Original) The method of Claim 14, wherein the media gateway and call session control format follows a H.248 standard.

17.   (Original) The method of Claim 14, wherein the media gateway and call session control format follows a SIP standard.

18.   (Original)   The   method   of   Claim   14,   further comprising:

providing the broadband loop emulation service signaling protocol to an integrated access device at a customer premises.

19.   (Original)   The   method   of   Claim   14,   wherein   the broadband   loop   emulation   services   signaling   protocol implements a channel associated signaling format.

20.   (Original)   The   method   of   Claim   14,   wherein   the broadband   loop   emulation   services   signaling   protocol implements a common channel signaling standard.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Eric Sean Parham, et al.

Serial No.:   09/685,274

Filing Date: October 9, 2000

Group Art Unit: 22662

Examiner: Dmitry Levitan

Title: SYSTEM AND METHOD FOR INTERFACING
                          BETWEEN SIGNALING PROTOCOLS

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that the attached Appeal Brief with check is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on this 29th day of June 2005, addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Willie Jiles
_____
Willie Jiles

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